JUDGE WOODS

16 CV 8086

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

ROBERT G. LOPEZ, an individual,	)	
	)	
Plaintiff,	)	
	)	
v.	)	**Civil Action No.**
	)	
AMERICAN EAGLE OUTFITTERS, INC.	)	**JURY TRIAL DEMANDED**
	)	
	)	
Defendant.	)	

FILED
U.S. DISTRICT COURT
2016 OCT 17 AM 9:48
S.D. OF N.Y.

COMPLAINT FOR TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND RELATED CLAIMS

Plaintiff, Robert G. Lopez, alleges his complaint against Defendant, American Eagle Outfitters as follows:

NATURE OF THE ACTION

1. This action arises from Defendant's infringement of Plaintiff's "ownership" and exclusive "use" rights in the marks LES NYC® and LOWER EAST SIDE™, in conjunction with clothing and other related goods. Despite Plaintiff being the registered owner of the trademark LES NYC® and LOWER EAST SIDE™ and offering various clothing items under such brand names, the Defendant has infringed Plaintiff's rights in the aforementioned marks by selling, and offering for sale clothing items under Plaintiff's trademark. Plaintiff has already experienced "actual confusion" in connection with this matter and is likely to continue to experience confusion as to the affiliation or connection between the Defendant and Plaintiff resulting in the unjust enrichment of Defendant's by using Plaintiff's registered trademarks.

JURISDICTION AND VENUE

2. This Court has jurisdiction over this action pursuant to 15 U.S.C. §1051 *et seq.*, 15 U.S.C. Sections 1114-1116; under Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a) and Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

3. This Court has personal jurisdiction over the Defendant because Defendant engages in business activities in, and directed to the State of New York within this judicial district and because Defendants have committed tortuous acts aimed at and causing harm within the State of New York and this judicial district.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) because it is where Plaintiff resides and the Defendant transact business in this district, and because a substantial portion of the events giving rise to the asserted claims have occurred, and continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property described herein continues to occur in this judicial district.

THE PARTIES

5. Plaintiff, Robert G. Lopez is an individual with a mailing address at 230 Clinton Street, Apt. #11C, New York, NY 10002.

6. Upon information and belief, Defendant American Eagle Outfitters, is a Delaware corporation with a principal place of business at 77 Hot Metal Street, Pittsburgh, Pennsylvania 15203.

FACTS

7. Since at least as early as 1999, Plaintiff Robert G. Lopez has been selling headwear, t-shirts, sweaters, hooded sweatshirts and other clothing items under the LES NYC® and LOWER EAST SIDE™ brand names.

8. Since at least as early as 1999, Plaintiff has been independently operating a clothing business under the trade name L.E.S. CLOTHING CO.™, which has sold headwear, t-shirts, sweaters, hooded sweatshirts and other related clothing items under the marks LOWER EAST SIDE™, LES™ and LES NYC®. Since at least as early as 2010, Plaintiff has also been selling clothing items under the mark LOYALTY EQUALS STRENGTH™ which is an additional representation of the LES™ brand acronym.

9. In addition to selling and offering for sale clothing items under the LOWER EAST SIDE™, LES™, LES NYC® and LOYALTY EQUALS STRENGTH™ brand names, Plaintiff has also continuously sold and offered for sale various clothing items including t-shirts which bear the LOWER EAST SIDE™ mark in various font and design styles which are prominently displayed on the front and/or back of the headwear, t-shirts and/or sweaters.

10. Plaintiff sells, and promotes the sale of his clothing via his website www.lesclothing.com, through order forms, and his t-shirts and sweaters are also available for sale in several retail locations in New York and other States.

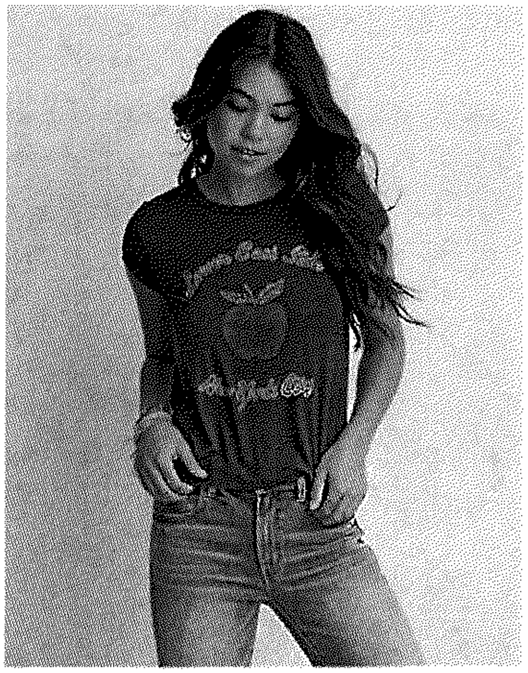
11. Plaintiff advertises his LES CLOTHING CO™, LOWER EAST SIDE™, LES™ and LES NYC® brands and clothing items through flyers, posters, stickers and through grass root street marketing methods such as painted "street murals." Plaintiff also regularly conducts photo shoots of customers who purchase his LOWER EAST SIDE™ and LES NYC® clothing items to be included in magazine advertisements and other marketing materials.

12. Plaintiff is the registered owner of United States Trademark Registration No. 4,549,880 for the mark LES NYC®. (**See Exhibit A**).

13. Plaintiff is the registered owner of New York State Trademark Registration No. R31067 and R32849 both for the mark LOWER EAST SIDE™. **(See Exhibit B).**

14. Plaintiff is informed and believes and thereon alleges that Defendant is marketing, promoting, selling and offering for sale t-shirts bearing the LOWER EAST SIDE™ and LES

NYC® marks depicted in the pictures below and also promoting the t-shirts under the title and heading 'Lower East Side' on its owned and operated website www.ae.com.



15. Defendant's marketing, offering and sale of t-shirts bearing the LOWER EAST SIDE™, LES™ and/or LES NYC® marks violate and infringe on Plaintiff's registered trademarks and the goodwill he has established under the aforementioned marks in connection with the sale of clothing.

16. Defendants use and infringement of Plaintiff's trademarks are done willfully as Defendants are aware of Plaintiff's ownership rights in his LOWER EAST SIDE™ and LES NYC® marks.

17. Defendant's use of Plaintiff's LOWER EAST SIDE™ brand in connection with clothing has already caused and will continue to cause confusion as to the source or affiliation of the source of the clothing related goods under the LOWER EAST SIDE™ mark. Defendants use of the mark LES™ or any slightly similar variation of Plaintiff's LES NYC® mark is also likely to cause additional instances of confusion in the marketplace as to the source or affiliation of

products being sold and offered under the LOWER EAST SIDE™ and/or LES NYC® brands owned by Plaintiff.

FIRST CAUSE OF ACTION

TRADEMARK INFRINGEMENT (15 U.S.C. §§ 1114-1116)

18. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 17 of this Complaint.

19. The use in commerce by Defendant of an identical and slightly identical version of Plaintiff's registered trademark is likely to cause confusion, mistake and deception among members of the public and in trade as to the source, origin, or sponsorship of defendants' goods and services. Such use by defendant constitutes a clear and direct infringement of Plaintiff's rights in and to Plaintiff's registered trademark, and has resulted in injury and damage to Plaintiff that will continue if Defendants are not ordered to cease all use of the LOWER EAST SIDE™ and LES NYC® marks.

SECOND CAUSE OF ACTION

UNFAIR COMPETITION & FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a)

20. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 19 of this Complaint.

21. Plaintiff has the exclusive right to market, brand and provide clothing related goods using the LES NYC® and LOWER EAST SIDE™ mark in connections with t-shirts and related goods.

22. Defendants by reason of the aforementioned acts, have falsely described, represented and designated the origin of its goods and services. Defendants' activities already have confused the public into believing that Defendants and Plaintiff's clothing goods and

accessories come from one and the same source, and defendants continued activities are likely to create further confusion and deceive the public concerning the source of the goods/services.

23. Defendants have unfairly profited from the actions alleged herein and will continue to unfairly profit and become unjustly enriched unless and until such conduct is enjoined by this Court.

24. By reason of Defendants willful acts conducted in conscious disregard for Plaintiff's rights, Plaintiff is entitled to treble damages under 15 U.S.C. § 1117(a).

THIRD CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT & UNFAIR COMPETITION

25. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 24 of this Complaint.

26. Defendant's conduct constitutes deception by which Defendant's goods will be palmed off as those of Plaintiff. Such conduct constitutes trademark infringement and unfair competition in violation of the laws of the State of New York.

27. Defendant's unauthorized use of Plaintiff's LOWER EAST SIDE™, and LES NYC® marks is likely to continue to cause further confusion to the public as to the clothing goods and accessories of the respective parties.

28. By reason of the foregoing, Defendant has infringed and continue to infringe on Plaintiff's common law rights in the LOWER EAST SIDE™, and LES NYC® marks and Defendants have become unjustly enriched by such acts of infringement.

29. Defendant's unlawful conduct has been and will continue to be willful or willfully blind to Plaintiff's rights, as Defendant has reason to know of Plaintiff's rights.

FOURTH CAUSE OF ACTION
UNJUST ENRICHMENT

30. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 29 of this Complaint.

31. Defendant has unjustly retained profits from the sale of clothing goods and accessories bearing Plaintiff's LOWER EAST SIDE™ and/or LES NYC® marks.

32. Defendant's actions constitute unjust enrichment.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:

1. Entry of an order and judgment requiring that Defendant, its subsidiaries, officers, agents, servants, employees, owners, and representatives, and all other persons or entities in active concert or participation with them, be preliminarily and, thereafter, permanently enjoined and restrained from (a) using in any manner the trade name, trademark, domain name or other indicia or origin, including in whole or part the term LOWER EAST SIDE™, LES NYC®, or any colorable imitation thereof; (b) advertising, operating a website, using business stationary or offering any goods or services using the trade name, trademark, domain name, URL, or any other indicia of origin including in whole or part the terms LOWER EAST SIDE™, LES NYC®, or any colorable imitation thereof; (c) otherwise engaging in any acts of unfair competition and infringement which tend to injure Plaintiff's rights in the LES NYC® mark.

2. That Defendant be required to account to Plaintiff for any and all profits derived by it, and to compensate Plaintiff for all the damages sustained by reason of the acts complained of herein, and that the damages herein be trebled pursuant to the Trademark Act.

3. That Defendant be ordered to deliver up for destruction any and all infringing materials bearing the LOWER EAST SIDE™ and LES NYC® marks, and any colorable imitation thereof, in whole or part.

4. That Plaintiff be awarded punitive damages.

5. That Defendant be required to place advertisements or send notifications to past and present customers that it improperly has been using the LOWER EAST SIDE™, and LES NYC® marks.

6. That Plaintiff be awarded the cost and disbursements of this action.

7. That Plaintiff have such other and further relief as the Court deems just and proper.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a trial by jury as to all issues.

Dated: October 17, 2016
New York, New York

Respectfully submitted,
Robert G. Lopez – Pro Se

Robert G. Lopez
Pro Se Plaintiff
230 Clinton Street – Apt. #11C
New York, New York 10002
(917) 868-1698

EXHIBIT A

United States of America
United States Patent and Trademark Office

LES NYC

Reg. No. 4,549,880
Registered June 17, 2014

LOPEZ, ROBERT G. (UNITED STATES INDIVIDUAL)
230 CLINTON STREET - APT. #11C
NEW YORK, NY 10002

Int. Cl.: 25

FOR: BASEBALL CAPS AND HATS; HOODED SWEATSHIRTS; SHORT-SLEEVED OR LONG-SLEEVED T-SHIRTS; T-SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

TRADEMARK

FIRST USE 12-0-1999; IN COMMERCE 12-0-1999.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SEC. 2(F).

SER. NO. 85-335,314, FILED 6-1-2011.

ALICE BENMAMAN, EXAMINING ATTORNEY

UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE

Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

EXHIBIT B

New York State Department of State
Certificate of Trademark Registration

I Daniel E. Shapiro, Special Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number:	*R31259*	***Registration Date:***	*05/12/08*
Applicant:	***ROBERT G. LOPEZ*** *230 CLINTON STREET, SUITE #11C* *NEW YORK*	*NY*	*10002-*
State of Incorporation or Partnership Organization:			
Class Numbers:	*25*		
Date First Used in NYS:	*12/1999*	***Date First Used Anywhere:***	*12/1999*

Trademark Description:

The mark is comprised of the words LES NYC inside of a circular design made up of stars.

Description of Goods: *Clothing, namely; T-shirts, Hooded Sweatshirts, Vest, Hats and Caps as adopted from the USPTO.*

WITNESS ***my hand and the seal of the State of New York In the City of Albany on this:***

Tuesday, June 10, 2008

by:

Special Deputy Secretary of State

DOS-690 (Rev. 3/01)

New York State Department of State
Certificate of Trademark Registration

I, Anthony Giardina, Executive Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number: *R32849* **Registration Date:** *08/09/16*

Applicant: *ROBERT G. LOPEZ*
230 CLINTON ST. - APT. 11C
NEW YORK *NY* *10002-*

State of Incorporation or Partnership Organization:

Class Numbers: *25*

Date First Used in NYS: *12/01/1999* **Date First Used Anywhere:** *12/01/1999*

Trademark Description:
The mark is comprised of the words LOWER EAST SIDE without claim to any particular font, style or design.

Description of Goods: *Clothing, namely; t-shirts, sweaters, shorts and headwear.*

WITNESS my hand and the seal of the State of New York in the City of Albany on this:

Thursday, August 11, 2016

by:

Anthony Giardina

Executive Deputy Secretary of State

DOS-690 (Rev. 8/13)